



BOX PATENT
Attorney Docket No. 24498

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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TECH CENTER 1600/2900

In re Application of:

VOELKEL, Helge

Serial No.: 09/744,016

Group Art Unit: 1652

Date Filed: January 19, 2001

Examiner: K.M. Kerr

For: **METHOD FOR SCREENING OF MODULATORS OF CALCINEURIN ACTIVITY**

TRANSMITTAL LETTER

Commissioner for Patents
Washington, D.C. 20231

Sir:

Submitted herewith for filing in the U.S. Patent and Trademark Office is the following:

- (1) Transmittal Letter
- (2) Response to Restriction Requirement

The Commissioner is hereby authorized to charge any deficiency or credit any excess to Deposit Account No. 14-0112.

Respectfully submitted,

NATH & ASSOCIATES PLLC

By: 

Gary M. Nath
Registration No. 26,965
Todd L. Juneau
Registration No. 40,669
Customer No. 20529

Date: September 12, 2002

NATH & ASSOCIATES PLLC
1030 15th Street N.W., 6th Floor
Washington, D.C. 20005
(202) 775-8383

GMN/TLJ/twk:RRR - xmittal



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Attorney Docket No. 24498

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

VOELKEL, Helge

Serial No.: 09/744,016

Group Art Unit: 1652

Date Filed: May 7, 2001

Examiner: K.M. Kerr

For: **METHOD FOR SCREENING OF MODULATORS OF CALCINEURIN ACTIVITY**

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

This is in response to the Office Action dated August 13, 2002, due for reply by September 13, 2002. Accordingly, this response is filed within the time period set by the Examiner.

SUMMARY OF RESTRICTION REQUIREMENT

The Examiner has required Applicant under 35 U.S.C. § 121 and 372 elect a single Invention Group from the following:

Group I: Claims 1-22, drawn to methods for screening modulators of calcineurin interacting with superoxide dimutase.

Group II: Claims 23, drawn to kits comprising calcineurin and superoxide dismutase or vectors of each.

As the basis for this restriction requirement, the Examiner contends that Groups I and II lack Unity of Invention under PCT Rule 13.2 for the following reasons:

The invention listed as Groups I-II do not relate to a single general inventive concept under PCT rule 13.2, they lack the same or corresponding special technical features for the following reasons:

"A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involved as least one common or corresponding special technical feature. The expression special technical feature is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art." (See M.P.E.P. § 1893.03(d))

Since the first claimed invention, Claim 1, lacks a special technical feature by virtue of its anticipation in the prior art (see PCT/ISA/210), it cannot share a special technical feature with the product claim, Claim 23. Thus Claims 1-22, all related method claims, lacks unity with Claim 23, a product claim useful for the method.

RESPONSE

Applicant elects the Group I (Claims 1-22, drawn to methods for screening modulators of calcineurin interacting with superoxide dimutase) with traverse.

Applicant respectfully traverse the Examiner's restriction requirement.

First, Applicant notes that the Examiner has cited the International Search Report (PCT/ISA/210) as the basis for the assertion that Group I "lacks a special technical feature by virtue of its anticipation in the prior art." The International Search

Report, dated December 20, 1999, lists several "X" references. A document categorized as an "X" reference denotes a special category of cited documents which are "documents of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is considered alone."

Applicant advises the Examiner that amended claims 1-23 were submitted via facsimile on September 28, 2000, more than 9 months after the date the International Search Report was prepared. An International Preliminary Examination Report "IPER" (PCT/IPEA/416), dated November 10, 2000 examined amended claims 1-23.

Under Section V. of the International Preliminary Examination Report, amended claims 1-23 were found to have novelty, inventive step and industrial applicability. The report states the following:

Although it is known from the prior art (D1: X. WANG ET AL.: 'Superoxide dimutase protects calcineurin from inactivation' NATURE, vol. 383, 3 October 1996 (1996-10-03), pages 434-437, XXP002124884 MACMILLIAN JOURNALS LTD., LONDON, UK cited in the application) that there is a certain interaction between SOD and calcineurin, complex formation between both components have not been reported, neither in D1 nor in any other document cited in the search report. Accordingly, the methods which make use of said complex as claimed in claims 1-22 are considered to be admissible under Articles 33(2) and 33(3) PCT. This also applies to the Kit as claimed in claim 23.

Applicant asserts that since the International Search Report was based on claims that were later amended, the Examiner's basis for the requiring restriction is not based on the claims currently pending. Further, since the International Preliminary Examination Report indicates that the pending claims have novelty, inventive step and industrial applicability, Applicant argues that grounds do not exist for requiring restriction based on a lack of novelty (anticipation in the art).

CONCLUSION

In view of the foregoing, applicants respectfully request the Examiner to reconsider and withdraw the restriction requirement, and to examine all of the claims pending in this application.

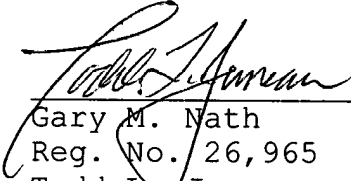
If the Examiner has any questions or comments regarding this matter, she is welcomed to contact the undersigned attorney at the below-listed number and address.

Respectfully submitted,

NATH & ASSOCIATES PLLC

Date: 12 Sept 2002

NATH & ASSOCIATES
1035 Fifteenth Street, N.W.
Sixth Floor
Washington, D.C. 20005
Tel: (202) 775-8383
Fax: (202) 775-8396
GMN:JBG:dhy/24286.rrr



Gary M. Nath
Reg. No. 26,965
Todd L. Juneau
Reg. No. 40,669
Customer No. 20529